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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
2001-028,219	04/09/2001	Jacob Leidner	209391	9737
CLASS 7590 12/17/2003 LEYDIG VOIT & MAYER, LTD 700 THIRTEENTH ST. NW SUITE 300 WASHINGTON, DC 20005-3960			EXAMINER SHOSHO, CALIE E	
			ART UNIT 1714	PAPER NUMBER

DATE MAILED: 12/17/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/828,219

Applicant(s)

LEIDNER ET AL.

Examiner

Callie E. Shosho

Art Unit

1714

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 08 October 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1,4,6-10,22-41 and 69-91 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1,4 and 6-10 is/are allowed.
- 6) ☒ Claim(s) 22-41 and 69-91 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.  
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

1. All outstanding rejections except for those described below are overcome by applicants' amendment filed 10/8/03.

**Claim Rejections - 35 USC § 102**

2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

3. Claims 22-23, 34-35, 37, 40-41, 69-74, 85, 87, and 90-91 are rejected under 35 U.S.C. 102(b) as being anticipated by Kitazawa (U.S. 5,595,700).

The rejection is adequately set forth in paragraph 5 of the office action mailed 4/9/03 and is incorporated here by reference.

4. Claims 22-24, 35-41, 69-75, 86, and 90-91 are rejected under 35 U.S.C. 102(b) as being anticipated by JP 02036281.

The rejection is adequately set forth in paragraph 6 of the office action mailed 4/9/03 and is incorporated here by reference.

**Claim Rejections - 35 USC § 103**

5. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

6. Claims 24-25, 27-32, 75-76, and 78-83 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kitazawa (U.S. 5,595,700) in view of either JP 03153778 or Grossman et al. (U.S. 4,371,632).

The rejection is adequately set forth in paragraph 8 of the office action mailed 4/9/03 and is incorporated here by reference.

7. Claims 33 and 84 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kitazawa (U.S. 5,595,700) in view of Koyama (U.S. 5,716,434).

The rejection is adequately set forth in paragraph 9 of the office action mailed 4/9/03 and is incorporated here by reference.

8. Claims 25-32, 76-83, and 87-89 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP 02036281 in view of either JP 03153778 or Grossman et al. (U.S. 4,371,632).

The rejection is adequately set forth in paragraph 10 of the office action mailed 4/9/03 and is incorporated here by reference.

9. Claims 33 and 84 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP 02036281 in view of Koyama (U. S. 5,716,434).

The rejection is adequately set forth in paragraph 11 of the office action mailed 4/9/03 and is incorporated here by reference.

**Response to Arguments**

10. Applicants' arguments filed 10/8/03 have been fully considered but they are not persuasive.

Specifically, applicants argue that the colored pencil lead of Kitazawa does not inherently form a cohesive layer as argued by the examiner in the office action mailed 4/9/03.

Applicants argue that given that the process of extruding Kitazawa's colored pencil lead involves only moderate temperatures, the polytetrafluoroethylene does not undergo melt processing but merely stays a powder, and thus, the colored pencil lead of Kitazawa cannot form a cohesive layer.

However, the above argument is not understood in light of the examples of the present specification wherein extrusion occurs at temperatures of 160-180 °C which does not appear to be significantly different than the "moderate" temperature disclosed by Kitazawa. That is, it is not clear why the colored pencil leads of the present composition which, like Kitazawa, do not appear to be extruded at high temperature form a cohesive layer while the colored pencil leads of Kitazawa do not form a cohesive layer. Clarification is requested.

Applicants also argue that the colored pencil lead of JP 02036281 does not inherently form a cohesive layer as argued by the examiner in the office action mailed 4/9/03.

Applicants argue that given that JP 02036281 discloses the use of porous inorganic substance which are not structurally cohesive, the colored pencil lead composition of JP 02036281 will not form a cohesive layer.

However, given that porous inorganic substance is just one of the ingredients in the colored pencil lead composition disclosed by JP 02036281, given that the composition of JP 02036281 also comprises fibrillatable copolymer, and given that page 7, lines 11-24 and examples 16-17 of the present specification disclose that it is the presence of the fibrillatable copolymer or copolymer that imparts cohesiveness to the mark formed by the colored pencil lead composition, it is not clear why the colored pencil lead of JP 02036281 does not form a cohesive layer. That is, although the colored pencil lead composition of JP 02036281 comprises porous inorganic substance, given that the composition also comprises fibrillatable copolymer which, according to the present specification, imparts cohesiveness, it is not clear why the colored pencil lead of JP 02036281 does not form a cohesive layer. Clarification is requested.

Further, with respect to the arguments regarding both Kitazawa and JP 02036281, it is noted that “the arguments of counsel cannot take the place of evidence in the record”, *In re Schulze*, 346 F.2d 600, 602, 145 USPQ 716, 718 (CCPA 1965). It is the examiner’s position that the arguments provided by the applicant regarding the fact that the colored pencil lead composition of either Kitazawa or JP 02036281 does not form a cohesive layer must be supported by a declaration or affidavit. As set forth in MPEP 716.02(g), “the reason for requiring evidence in a declaration or affidavit form is to obtain the assurances that any statements or representations made are correct, as provided by 35 U.S.C. 24 and 18 U.S.C. 1001”.

**Allowable Subject Matter**

11. Claims 1, 4, and 6-10 are allowable over the “closest” prior art for the following reasons:

Kitazawa (U.S. 5,595,700) discloses erasable colored pencil lead composition comprising filler, colorant, binder, and polytetrafluoroethylene, i.e. fibrillatable material wherein the use of wax is not required. However, there is no disclosure or suggestion that the binder is a polyolefin as required in present claims 1, 4, and 6-10.

JP 02036281 discloses erasable colored pencil lead composition comprising polyethylene binder, fibrillatable ethylene-vinyl acetate copolymer, lubricant, filler, and colorant, however, the composition of JP 02036281 utilizes low melting waxes which is in direct contrast to present claims 1, 4, and 6-10 which require that the composition be substantially free of such waxes.

12. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

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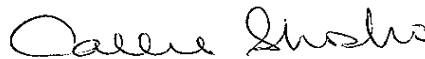
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13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Callie E. Shosho whose telephone number is 571-272-1123. The examiner can normally be reached on Monday-Friday (6:30-4:00) Alternate Fridays Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on 571-272-1119. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.



Callie E. Shosho  
Primary Examiner  
Art Unit 1714

CS  
12/5/03